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<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional) 1103326-0659	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>February 27, 2006</u> Signature <u>Andrew Fessak</u> Typed or printed name <u>Andrew Fessak</u>		Application Number 09/806,801	Filed Apr. 4, 2001
		First Named Inventor Folestad et al.	
		Art Unit 2856	Examiner Paul M. West
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.  This request is being filed with a notice of appeal.  The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>48,528</u> <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____		Signature <u>Andrew Fessak</u> Typed or printed name <u>Andrew Fessak</u> Telephone number <u>(212) 819-8437</u> Date <u>February 27, 2006</u>	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.			
<input type="checkbox"/> Total of _____ forms are submitted.			

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FEB 27 2006

1103326-0659

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Folestad et al.  
Serial No. : 09/806,801  
Filed : April 4, 2001  
For : APPARATUS AND METHOD FOR ANALYSING  
Examiner : Paul M. West  
Group Art Unit : 2856

<b>CERTIFICATE OF TRANSMISSION UNDER 37 C.F.R. §1.8</b>	
I hereby certify that this paper is being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below at the facsimile number <u>1-571-273-8300</u> .	
Andrew Fessak	48,528
Agent Name	PTO Reg. No.
<i>Andrew Fessak</i>	<i>2/27/06</i>
Signature	Date of Signature

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Pages: 6 pages total  
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**REMARKS ACCOMPANYING**  
**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Sir:

Applicants request review of the final rejection in the Office Action mailed October 31, 2005 in the referenced application. Attached are Applicants' Pre-Appeal Brief Request for Review (Form PTO/SB/33) and Notice of Appeal (Form PTO/SB/31).

Applicants petition for a one-month extension of time for responding to the final Office Action. The Assistant Commissioner is authorized to charge the one-month extension of time fee of \$120.00 under 37 C.F.R. §1.17(a)(1), and the Notice of Appeal fee of \$500.00 under 37 C.F.R. §41.20(b)(1) to Deposit Account No. 23-1703.

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NEWYORK 5421818 v1 (2K)

**REMARKS****I. Grounds for requesting pre-appeal brief conference**

By this communication, Applicants request that an appeal panel of examiners review the legal and factual basis of the final Office Action mailed on October 31, 2005 (the "final Office Action") and the subsequent Advisory Action mailed on January 23, 2006 (the "Advisory Action") in the referenced application. The final Office Action was issued in response to Applicants' Amendment (the "Amendment") filed on August 26, 2005, and the Advisory Action was issued in response to Applicants' request for reconsideration filed on December 8, 2005.

A telephonic interview occurred on May 17, 2005 with the Examiner and Applicants' representatives. In response to a nonfinal Office Action, mailed June 1, 2005, claims 1, 18, 27, and 28 were amended by the Amendment along the lines of the Examiner Interview as summarized by the Interview Summary of record, mailed on May 20, 2005. For example, the expression "adapted to move" was deleted from the claims. All of the pending claims 1-3, 6-23, and 25-28 are in the form as of the date of the Amendment and have not been subsequently amended.

Applicants submit that the Examiner did not provide any explanation in the final Office Action for maintaining the §103(a) rejections of record over the claims as amended by the Amendment. Rather, the final Office Action is essentially a verbatim repeat of the previous Office Actions which issued prior to the Amendment and the claim amendments. As such, the final Office Action is silent with regard to the claim amendments and arguments set forth in the Amendment.

Applicants filed a response to the final Office Action and pointed out the Examiner's failure to address the claim amendments and arguments set forth in the Amendment. However, in the Advisory Action, the Examiner merely asserted that the Office Action states why the claims are rejected. However, an examination of the record shows that this is not the case. The final Office Action does *not* discuss how the most recent amendments and arguments fail to overcome the outstanding prior art rejections.

It is respectfully submitted, therefore, that the Examiner erred by failing to substantiate a *prima facie* case of obviousness with respect to the claims as amended by the Amendment. This

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is particularly striking since the claims were amended along the lines of the Examiner Interview. Accordingly, for this reason, the prosecution history of the referenced application appears to be compromised with factual and/or legal error, and Applicants are entitled to relief in the form of a withdrawal of the §103(a) rejections of record in view of the claim amendments or a substantiation of the prior art rejection of the amended claims.

## II. Outstanding rejections

For the convenience of the Appeals Panel, the outstanding rejections are given below.

Claims 1-3, 6-11, 17, and 26 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over EP 896,215 to Hammond et al. ("Hammond") in view of EP 767,369 to Trygstad ("Trygstad"), US 5,463,223 to Wong et al. ("Wong"), and DE 4441686 to Schilling ("Schilling").

Claims 12, 14-16, 18-23, and 25 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Hammond in view of Trygstad and Schilling.

Claims 27 and 28 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Hammond in view of Wong.

## III. Errors in the Examiner's rejections.

Applicants submit that Examiner has not established a *prima facie* case of unpatentability over the amended claims in view of the cited combination of Hammond, Trygstad, Schilling, and Wong. None of these cited documents, whether alone or in combination, discloses or suggests a sample presentation apparatus as presently claimed.

In support of their Request, Applicants refer the Appeals Panel to the following: (a) the Interview Summary dated May 17, 2005; (b) the Amendment filed on March 31, 2005, pages 7-12; and (c) the Amendment filed on August 26, 2005, pages 7-10, in distinguishing the claimed invention over Hammond, Trygstad, Schilling, and Wong.

The need to rely upon four separate references to allegedly arrive at the claimed invention confirms its non-obviousness. The blatant reconstruction of the invention would not have been

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possible without the benefit of Applicants' disclosure. Applicants therefore submit that the prior art rejection of record over the amended claims is based on impermissible hindsight.

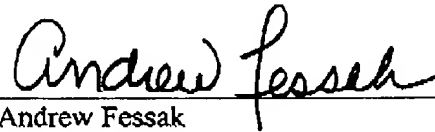
#### IV. Conclusion

Applicants respectfully submit that they have been unfairly prejudiced by the Examiner's failure to address the claim amendments and arguments set forth in the Amendment. Claims 1-3, 6-23, and 25-28 are patentable over the cited prior art set forth in the Amendment. Accordingly, Applicants request reconsideration and allowance of the claims, or at a minimum, reissuance of the Office Action with a detailed discussion of the most recent claim amendments in view of the art of record.

Authorization is hereby given to charge any fee due in connection with this communication to Deposit Account No. 23-1703.

Dated: Feb. 27, 2006

Respectfully submitted,



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Enclosures: Pre-Appcal Brief Request for Review (Form PTO/SB/33) (1 page)  
Notice of Appeal (Form PTO/SB/31) (1 page)